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TO: U.S. Patent Office – Appeal Brief - Patents

NAME: Appeal Communication

DATE & TIME: 06/18/2004

CONFIRMATION:

PAGES TO FOLLOW: 23

FAX NUMBER: 703-308-7952

FROM: Morris, Manning & Martin, LLP

CHARGE TO:

NAME: John R. Harris

CLIENT/MATTER: 10722-31459

PHONE: (404) 233-7000

CONFIRMATION TIME:

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COMMENTS:

Application No.: 09/737,912

Filing Date: 12/15/2000

Attorney Docket No. 10722-31459

I hereby certify that the attached documents are being sent via facsimile to the USPTO this 18th day of June, 2004:

Transmittal Form – 1 page;

Fee Transmittal Form – 1 page;

Credit Card Payment Form – 1 page;

Appellant's Brief Under 37 C.F.R. §1.192 20 pages.


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Patent No.	Patent No.	Registration No.	
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U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

FEE TRANSMITTAL for FY 2004

Effective 10/01/2003. Patent fees are subject to annual revision.

☐ Applicant claims small entity status. See 37 CFR 1.27

TOTAL AMOUNT OF PAYMENT (\$) 330

Complete if Known

Application Number 09/737,912
Filing Date 12/15/2000
First Named Inventor Karas, et al.
Examiner Name C. Nguyen
Art Unit 3625
Attorney Docket No. 10722-31459

METHOD OF PAYMENT (check all that apply)

☐ Check ☒ Credit card ☐ Money Order ☐ Other ☐ None

☐ Deposit Account:

Deposit Account Number
Deposit Account Name

The Director is authorized to: (check all that apply)

☐ Charge fee(s) indicated below ☐ Credit any overpayments
☐ Charge any additional fee(s) or any underpayment of fee(s)
☐ Charge fee(s) indicated below, except for the filing fee to the above-identified deposit account.

FEE CALCULATION

1. BASIC FILING FEE

Large Entity Fee Code (\$)	Small Entity Fee Code (\$)	Fee Description	Fee Paid
1001 770	2001 385	Utility filing fee	
1002 340	2002 170	Design filing fee	
1003 530	2003 265	Plant filing fee	
1004 770	2004 385	Reissue filing fee	
1005 160	2005 80	Provisional filing fee	

SUBTOTAL (1) (\$) 0

2. EXTRA CLAIM FEES FOR UTILITY AND REISSUE

Total Claims	Extra Claims	Fee from below	Fee Paid
Independent Claims	-20** =	X	
Multiple Dependent	-3** =	X	

Large Entity Fee Code (\$)	Small Entity Fee Code (\$)	Fee Description
1202 18	2202 9	Claims in excess of 20
1201 86	2201 43	Independent claims in excess of 3
1203 290	2203 145	Multiple dependent claim, if not paid
1204 86	2204 43	** Reissue independent claims over original patent
1206 18	2206 9	** Reissue claims in excess of 20 and over original patent

SUBTOTAL (2) (\$) 0

**or number previously paid, if greater; For Reissues, see above

FEE CALCULATION (continued)

3. ADDITIONAL FEES

Large Entity Fee Code (\$)	Small Entity Fee Code (\$)	Fee Description
1051 130	2051 65	Surcharge - late filing fee or oath
1052 50	2052 25	Surcharge - late provisional filing fee or cover sheet
1053 130	1053 130	Non-English specification
1812 2,520	1812 2,520	For filing a request for ex parte reexamination
1804 920*	1804 920*	Requesting publication of SIR prior to Examiner action
1805 1,840*	1805 1,840*	Requesting publication of SIR after Examiner action
1251 110	2251 55	Extension for reply within first month
1252 420	2252 210	Extension for reply within second month
1253 850	2253 475	Extension for reply within third month
1254 1,480	2254 740	Extension for reply within fourth month
1255 2,010	2255 1,005	Extension for reply within fifth month
1401 330	2401 165	Notice of Appeal
1402 330	2402 165	Filing a brief in support of an appeal
1403 290	2403 145	Request for oral hearing
1451 1,510	1451 1,510	Petition to institute a public use proceeding
1452 110	2452 55	Petition to revive - unavoidable
1453 1,330	2453 665	Petition to revive - unintentional
1501 1,330	2501 665	Utility issue fee (or reissue)
1502 480	2502 240	Design issue fee
1503 840	2503 320	Plant issue fee
1460 130	1460 130	Petitions to the Commissioner
1807 50	1807 50	Processing fee under 37 CFR 1.17(q)
1808 180	1808 180	Submission of Information Disclosure Stmt
8021 40	8021 40	Recording each patent assignment per property (times number of properties)
1809 770	2809 385	Filing a submission after final rejection (37 CFR 1.129(a))
1810 770	2810 385	For each additional invention to be examined (37 CFR 1.129(b))
1801 770	2801 385	Request for Continued Examination (RCE)
1802 900	1802 900	Request for expedited examination of a design application

Other fee (specify)

*Reduced by Basic Filing Fee Paid

SUBTOTAL (3) (\$) 330

SUBMITTED BY

Name (Print/Type) John R. Harris
Signature *John R. Harris*

Registration No. (Attorney/Agent)

30,388

(Complete if applicable)

Telephone 404/233-7000

Date June 18 2004

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**TRANSMITTAL
FORM**

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Total Number of Pages in This Submission

Application Number	09/737,912
Filing Date	12/15/2000
First Named Inventor	Karas, et al.
Art Unit	3625
Examiner Name	C. Nguyen
Attorney Docket Number	10722-31458

ENCLOSURES (Check all that apply)

- | | | |
|--|--|--|
| <input checked="" type="checkbox"/> Fee Transmittal Form
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<input type="checkbox"/> Information Disclosure Statement
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<input type="checkbox"/> Response to Missing Parts/Incomplete Application
<input type="checkbox"/> Response to Missing Parts under 37 CFR 1.52 or 1.53 | <input type="checkbox"/> Drawing(s)
<input type="checkbox"/> Licensing-related Papers
<input type="checkbox"/> Petition
<input type="checkbox"/> Petition to Convert to a Provisional Application
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Firm or Individual name	John R. Harris Morris, Manning & Martin, LLP
Signature	<i>John R. Harris</i>
Date	June 18, 2004

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Patents

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: **Karas**

Serial No. 09/737,912

Filed: December 15, 2000

For: **ONLINE METHOD AND
SYSTEM FOR ORDERING AND
HAVING DELIVERED A PAPER
GREETING MESSAGE AND A
PAYMENT INSTRUMENT**

Art Unit: 3625

Examiner: **Nguyen, Cuong H**

Confirmation No.: 2437

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Mail Stop Appeal Brief-- Patents
Commissioner for Patents
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Alexandria, Virginia 22313-1450

APPELLANT'S BRIEF UNDER 37 C.F.R. §1.192

I. REAL PARTY IN INTEREST

The subject application is owned by First Data Corporation of Greenwood Village, Colorado.

II. RELATED APPEALS AND INTERFERENCES

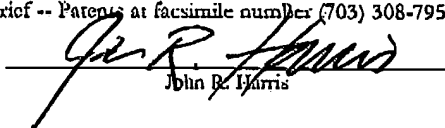
There are no other known appeals or interferences related to this appeal.

III. STATUS OF CLAIMS

Claims 1-8 and 11-29 are pending in the present application (see Appendix). In a final rejection mailed March 15, 2004, the Examiner rejected claims 1-8 and 11-29 under 35

Certificate of Facsimile

The undersigned hereby certifies that on June 18, 2004 this document for Application Serial No. 09/737,912 was sent by facsimile to the attention of U.S. Patent Office - Appeal Brief -- Patents at facsimile number (703) 308-7952.


John R. Harris

PATENTS
APPLICATION SERIAL NUMBER 09/737,912
ONLINE METHOD AND SYSTEM FOR ORDERING AND HAVING DELIVERED
A PAPER GREETING MESSAGE AND PAYMENT INSTRUMENT

U.S.C. §103(a) as being allegedly obvious over U.S. Patent No. 6,453,300 to *Simpson* in view of U.S. Patent No. 5,893,080 to *McGurl*. Some of claims 1-8 and 11-29 were rejected under 35 U.S.C. §103(a) in further view of U.S. Patent No. 5,960,412 to *Tackebary*. Applicant submitted a Notice of Appeal on April 15, 2004 appealing the rejection of claims 1-8 and 11-29.

IV. STATUS OF AMENDMENTS

No amendments are presented.

V. SUMMARY OF INVENTION

The following is a concise explanation of the various inventions set forth in claims 1-8 and 11-29. The independent claims at issue are claims 1, 17, and 29.

The present invention, as recited in claims 1-8 and 11-29, generally relates to an online or computerized method and system for enabling a sender of a message (e.g., an individual) to order a paper greeting message containing a negotiable instrument (referred to in the specification as a "gift-gram")¹. The paper greeting message includes a paper item that is customizable or personalizable and has included therewith or attached thereto a negotiable payment instrument, such as a check or money order (p. 11, lines 18-22; p. 12, line 5). The method and system are designed to facilitate purchase of the paper greeting message through a computer and yet provide for direct physical delivery of the paper greeting message to a recipient (p. 1, lines 22-24 through p. 2, lines 5-6; p. 7, lines 17-19; FIG. 7; FIG. 12). The payee specified on the paper greeting message is not necessarily the recipient of the paper greeting message.

Specifically, claim 1 relates to a method in which a buyer directs a seller to create a printed greeting message having a negotiable payment instrument included therewith to a

¹ It has been determined that the term "gift-gram" is being used as a trademark of the Applicant. It should be understood that the previous use of the term "gift-gram" as a noun in the specification should not be taken as an admission that the term is or has become generic; rather, the use in such manner was inadvertent and erroneous and will be corrected prior to issuance of the patent.

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recipient, including various steps of: enabling the sender to select a graphic image for inclusion in the message to the recipient, enabling the sender to input customized text for inclusion in the message, enabling the sender to specify a payee for the negotiable payment instrument, enabling the sender to specify the monetary value of the negotiable payment instrument, requesting payment authorization for at least the monetary value of the negotiable payment instrument based on billing information provided by the sender, and after payment authorization has been obtained, printing the message and negotiable payment instrument by the seller, the message including the graphic image and customized text selected by the sender, the negotiable payment instrument including the payee and the monetary value selected by the sender.

Claim 17 relates to a system for enabling a sender having access to a server of an online seller to order from the seller and have delivered directly to a recipient a customized greeting message having a negotiable payment instrument included therewith, including a means for selecting a graphic image for inclusion in the message, means for specifying customized text for inclusion in the message, means for specifying a payee for the negotiable payment instrument, means for selecting the monetary value of the negotiable payment instrument, means for specifying billing information for the message and the negotiable instrument, wherein the billing information includes a financial institution of the sender, means for requesting billing authorization from the financial institution of the sender, means for printing the message and negotiable payment instrument; and means for mailing the message and negotiable payment instrument to the recipient.

Claim 29 relates to a method of directing a seller to create and send to a recipient a printed negotiable payment instrument having a customized greeting message, including various steps of: receiving customized text from the sender for inclusion in the message, receiving a mailing address for the recipient from the sender, receiving payee information from the sender, the payee information specifying the payee for the negotiable payment instrument, enabling the sender to specify a monetary value of the negotiable payment instrument, receiving a requested mailing date from the sender, printing the negotiable

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payment instrument, the message included on a stub portion of the negotiable payment instrument, the negotiable payment instrument made payable to the payee and for an amount corresponding to the monetary value selected by the sender, and causing the printed negotiable instrument to be mailed to the mailing address of the recipient on the requested mailing date.

VI. ISSUES

The issue of this appeal is whether independent claims 1, 17, and 29 and their associated dependent claims are obvious under 35 U.S.C. §103(a) over U.S. Patent No. 6,453,300 to *Simpson* in view of U.S. Patent No. 5,893,080 to *McGurl*, and with respect to some claims, in further view of U.S. Patent No. 5,960,412 to *Tackbary*.

VII. GROUPING OF CLAIMS

For purposes of this appeal, and not in derogation of 35 U.S.C. §282, the following are the claim groupings for which the appellant presents separate arguments for patentability.

Applicant groups Claims 1-8 and 11-16 for consideration of patentability.

Applicant groups Claims 17-28 for consideration of patentability.

Applicant groups Claim 29 alone for consideration of patentability.

Claims 1, 17, and 29 are independent claims, which do not stand or fall together. Each of these independent claims include limitations that are not disclosed, taught, or suggested by *Simpson*, *McGurl*, or *Tackbary*, alone or in combination with each other.

VIII. ARGUMENT

There are two arguments presented in this appeal. First, the Examiner has failed to establish a *prima facie* case of obviousness under 35 U.S.C. §103(a). Second, even if the Examiner has made a *prima facie* case of obviousness under 35 U.S.C. §103(a), Applicant's

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claimed invention is not obvious over the combination of *Simpson* and *McGurl*. Thus, the Examiner's final rejection of claims 1-8 and 11-29 is improper and should be withdrawn.

A. The Examiner Has Failed to Make a *Prima facie* Case of Obviousness to Support a Rejection under 35 U.S.C. §103(a).

In the Final Office Action dated March 15, 2004, the Examiner rejected claims 1-8 and 11-29 under 35 U.S.C. §103(a) as being obvious over *Simpson* in view of *McGurl*. This rejection is respectfully traversed.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference or combination of references must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on Applicant's disclosure. *In re Vaecke*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991); MPEP §2142.

It is respectfully submitted that the Examiner has failed to make a *prima facie* case to support a rejection of any claims under 35 U.S.C. §103(a) over *Simpson* in view of *McGurl*. First, there is no suggestion or motivation to modify the references or combine the reference teachings. Second, there is no reasonable expectation of success of combining the reference teachings. Finally, the combination of references does not teach or suggest all elements of Applicant's claims.

1. There is No Suggestion or Motivation to Modify the References or Combine the Reference Teachings.

In the Final Office Action dated March 15, 2004, claims 1-8 and 11-29 were rejected under 35 U.S.C. 103(a) as being allegedly obvious over *Simpson* in view of *McGurl*. This rejection is respectfully traversed.

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Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988); *In re Jones*, 958 F.2d 347, 21 U.S.P.Q.2d 1941 (Fed. Cir. 1992). In the present case, the Examiner has not even attempted to provide a motivation to combine the reference teachings. As explained hereinafter, such motivation cannot be obtained from the cited references.

For example, *Simpson* is directed to an improved greeting card having an electronic storage media, such as a compact disk (CD), contained therein, and a method of enabling the purchaser of the card to personalize the card for the intended recipient for whom the card was purchased (col. 1, lines 18-24). The greeting card of *Simpson* is typically provided in a shape suitable for containing a CD or other similarly shaped storage medium (col. 3, lines 37-39). Through various techniques described in *Simpson*, a personalized message stored in the seller's database becomes associated with identification data on the CD (col. 5, lines 33-38). When the recipient receives the greeting card of *Simpson*, the recipient inserts the CD into a CD-ROM drive and plays the CD (col. 5, lines 44-46). The CD automatically directs the recipient to a website where data is stored by the seller of the greeting card (col. 5, lines 54-56). The greeting then displays for the recipient to view (col. 5, lines 58-61). After the personalized message is displayed, a generic set of information stored on the CD is then displayed (col. 6, lines 1-2, 14-15, 20-24). Specifically, a subset of a larger generic set is displayed (col. 6, lines 24-28). For example, the CD may contain interesting facts about dates in each month of the year, and only the month of birth of the recipient is then displayed (col. 6, lines 9-11). *Simpson* makes no mention of generating a negotiable instrument to be included with the greeting.

McGurl is directed to a computerized payment disbursement system (col. 2, lines 44-45). *McGurl* essentially reaches a computerized checking account where disbursement data is stored, recalled, archived, and/or inputted, and financial reports are generated (col. 4, lines

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45-47; col. 4, lines 21, 54, 60). *McGurl* is primarily directed to methods and systems for having disbursements (electronic or printed checks) made in such a manner that unauthorized disbursements from the system are prevented. *McGurl* is not directed to a personalized greeting message.

Applicant has diligently searched the cited references and is unable to find any motivation whatsoever to combine the reference teachings. For instance, *Simpson* does not teach or suggest use of a computerized disbursement system such as that described in *McGurl* to generate the CD gift card. Likewise, *McGurl* does not teach or suggest use of a payment disbursement system to generate gift cards, CD gift cards, or any other kind of printed greeting message having a negotiable instrument included therewith.

Thus, Applicant submits that the Examiner has failed to identify any suggestion or motivation to modify the references or combine the teachings of *Simpson* and *McGurl*. As such, the Examiner has failed to make a *prima facie* case of obviousness under 35 U.S.C. §103(a). Therefore, the rejection under 35 U.S.C. §103(a) is improper and should be withdrawn.

2. There is No Reasonable Expectation of Success of Combining the References.

Applicant submits that the Examiner has failed to identify a reasonable expectation of success in combining the teachings of *Simpson* and *McGurl*. As such, the Examiner has not established a *prima facie* case of obviousness under 35 U.S.C. §103(a). Therefore, for this additional reason, the rejection is improper and should be withdrawn.

Applicant respectfully submits that there is no reasonable expectation of success in combining the reference teachings. The prior art can be modified or combined to reject claims as *prima facie* obvious as long as there is a reasonable expectation of success. *In re Merck & Co., Inc.*, 800 F.2d 1091, 231 U.S.P.Q. 375 (Fed. Cir. 1986). Obviousness does not require absolute predictability; however, at least some degree of predictability is required. Evidence showing there was no reasonable expectation of success may support a conclusion of nonobviousness. *In Re Rinehart*, 531 F.2d 1048, 189 U.S.P.Q. 143 (CCPA 1976). In this

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instance, Applicant submits that there is no reasonable expectation of success in combining the teachings of *Simpson* and *McGurl* to support a rejection under 35 U.S.C. §103(a). It is difficult to fathom how one could be successful in creating a paper greeting having a negotiable instrument included therewith when the references combined are completely silent with respect to various elements of Applicant's claimed invention.

As discussed previously, there is no motivation to combine the cited references because there is simply no reason set forth in the cited references that would encourage one of ordinary skill in the art to modify the cited references to arrive at the claimed invention. The references are directed to entirely different concepts and do not point to each other in any manner. Since there is no motivation to combine the reference teachings, there is likewise no expectation that combining the references would result in a successful combination. Furthermore, there is no expectation that combining the references would result in Applicant's claimed inventions, as discussed in greater detail below.

3. The Combination of References Does Not Teach or Suggest All Elements of Applicant's Claimed Invention.

To establish a *prima facie* case of obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). "All the words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). Furthermore, if an independent claim is nonobvious under 35 U.S.C. §103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988). Applicant asserts that the combination of *Simpson* and *McGurl* fails to teach or suggest all elements of Applicant's claimed invention, and therefore, is insufficient to support a rejection under 35 U.S.C. §103(a).

As stated above, Applicant's invention is generally directed to an online or computerized method and system for enabling a sender to order a paper greeting message. The paper greeting message can be customized or personalized and has included therewith or attached thereto a negotiable payment instrument, such as a check or money order (p. 11,

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lines 18-22; p. 12, line 5). The method and system are designed to facilitate purchase of the paper greeting message through a computer and yet provide for direct physical delivery of the paper greeting message to a recipient (p. 1, lines 22-24 through p. 2, lines 5-6; p. 7, lines 17-19; FIG. 7; FIG. 12). The payee specified on the paper greeting message is not necessarily the recipient of the paper greeting message.

In general, neither *Simpson* nor *McGurl*, alone or in combination, teach or suggest a system in which a buyer can direct a seller to prepare and deliver a customized paper greeting message with a negotiable instrument included therewith or attached thereto, as recited in Applicant's claims 1, 17, and 29.

Additionally, in the Final Office Action, the Examiner asserted that certain claims were obvious in further view of U.S. Patent 5,960,412 to *Tackbary et al.* ("*Tackbary*"). *Tackbary* is directed to a method for on-going management, selection, and delivery of social expression cards (col. 1, lines 19-22). This system is quite similar to the known online greeting card systems described in the Background of the Invention of the present application (Application, p. 1-2). A user is able to access the owner's database via the Internet, store occasion dates, select a card, and have it delivered to a recipient (col. 2, lines 47-50; col. 4, lines 9-11).

Tackbary does not cure the deficiencies of *Simpson* and *McGurl*. Even if the references are combined, the combination fails to disclose all elements of Applicant's claimed invention. None of the references, alone or in combination, teach or suggest direct creation and delivery of a printed greeting card with a negotiable instrument by a third party online seller. *Tackbary* alludes to inclusion of a check or charitable contribution with the social expression card, but *Tackbary* does not explain who would generate the check, how the payee would be specified, how the amount of the check or charitable contribution would be specified, how the check or charitable contribution would be forwarded to a payee, and so forth. The mere fact that *Tackbary* alludes to inclusion of a check with a greeting card does not render the Applicant's invention obvious. Indeed, the notion of including a check with a greeting card is well

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known, and it would be improper to construe *Tackbary* as disclosing any more than it actually teaches.

Given that the combination of *Simpson*, *McGurl*, and *Tackbary* clearly does not teach or suggest all elements of Applicant's claimed invention, it is respectfully submitted that the Examiner has failed to establish a *prima facie* case of obviousness with respect to claims 1-8 and 11-29. Thus, the combination of *Simpson*, *McGurl*, and *Tackbary* is insufficient to support a rejection under 35 U.S.C. §103(a).

4. Conclusion

It is respectfully submitted that the Examiner has failed to make a *prima facie* case of obviousness. First, there is no motivation to combine the references. Second, there is no reasonable expectation of success in combining the references. Finally, the combination of *Simpson*, *McGurl*, and *Tackbary* fails to teach and enable every element of Applicant's claimed inventions as set forth in claims 1-8 and 11-29. Therefore, the rejection under §103(a) with respect to the combination of *Simpson* and *McGurl* is improper and should be withdrawn.

C. Even if the Examiner Has Made a *Prima facie* Case of Obviousness Under 35 U.S.C. §103(a), Applicant's Claimed Invention is Not Obvious Over the Combination of *Simpson* and *McGurl*.

It is respectfully submitted that Applicant's claimed inventions as recited in claims 1-8 and 11-29 are not obvious over *Simpson* in view of *McGurl*. In *Graham v. John Deere*, 383 U.S. 1, 148 U.S.P.Q. 459 (1966), the Supreme Court set forth four factual inquiries to be made when making an obviousness determination. First, the scope and content of the prior art is determined. Next, the differences between the prior art and the claims at issue is ascertained. Then, the level of ordinary skill in the art is resolved. Secondary considerations of nonobviousness may be evaluated. Finally, a determination of obviousness is made. MPEP §2101.

1. Scope and Content of the Prior Art

Simpson is directed to an improved greeting card having an electronic storage media, such as a compact disk (CD), contained therein, and a method of enabling the purchaser of

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the card to personalize the card for the intended recipient for whom the card was purchased (col. 1, lines 18-24). The greeting card of *Simpson* may typically be provided as a shape suitable for containing a CD or other similarly shaped storage medium (col. 3, lines 37-39). Through various techniques described in *Simpson*, a personalized message stored in the seller's database becomes associated with identification data on the CD (col. 5, lines 33-38). When the recipient receives the greeting card of *Simpson*, the recipient inserts the CD into a CD-ROM drive and plays the CD (col. 5, lines 44-46). The CD automatically directs the recipient to a website where data is stored by the seller of the greeting card (col. 5, lines 54-56). The greeting then displays for the recipient to view (col. 5, lines 58-61). After the personalized message is displayed, a generic set of information stored on the CD is then displayed (col. 6, lines 1-2, 14-15, 20-24). Specifically, a subset of a larger generic set is displayed (col. 6, lines 24-28). For example, the CD may contain interesting facts about dates in each month of the year, and only the month of birth of the recipient is then displayed (col. 6, lines 9-11).

McGurl is directed to a computerized payment disbursement system (col. 2, lines 44-45). *McGurl* essentially teaches a computerized checking account where disbursement data is stored, recalled, archived, and/or inputted, and financial reports are generated (col. 4, lines 45-47; col. 4, lines 21, 54, 60). *McGurl* is primarily directed to methods and systems for having disbursements (electronic or printed checks) made in such a manner that unauthorized disbursements from the system are prevented.

2. Differences Between the Prior Art and the Claimed Invention

Applicant's inventions, as recited in claims 1-8 and 11-29, are directed to an online or computerized method and system for enabling a sender to order a paper greeting message. The paper greeting message can be customized or personalized and has included therewith or attached thereto a negotiable payment instrument, such as a check or money order (p. 11, lines 18-22; p. 12, line 5). The method and system are designed to facilitate purchase of the paper greeting message through a computer and yet provide for direct physical delivery of the paper greeting message to a recipient (p. 1, lines 22-24 through p. 2, lines 5-6; p. 7, lines

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17-19; FIG. 7; FIG. 12). The payee specified on the paper greeting message is not necessarily the recipient of the paper greeting message.

In general, neither *Simpson* nor *McGurl*, alone or in combination, teach or suggest a method or system in which a buyer can direct a seller to prepare and deliver a customized paper greeting message with a negotiable instrument included therewith or attached thereto, as set forth in Applicant's claims 1, 17, and 29.

In particular, with respect to claim 1, the combination of *Simpson* and *McGurl* fails to teach or suggest, in a computer network system including a seller and a sender, the sender having access to an online server of the seller, a method of directing the seller to create a printed greeting message having a negotiable payment instrument included therewith to a recipient, including the steps of: enabling the sender to select a graphic image for inclusion in the message to the recipient, enabling the sender to input customized text for inclusion in the message, enabling the sender to specify a payee for the negotiable payment instrument, enabling the sender to specify the monetary value of the negotiable payment instrument, requesting payment authorization for at least the monetary value of the negotiable payment instrument based on billing information provided by the sender, and after payment authorization has been obtained, printing the message and negotiable payment instrument by the seller, the message including the graphic image and customized text selected by the sender, the negotiable payment instrument including the payee and the monetary value selected by the sender.

With respect to claim 17, the combination of *Simpson* and *McGurl* fails to teach or suggest a computer network system for enabling a sender having access to a server of an online seller to order from the seller and have delivered directly to a recipient a customized greeting message having a negotiable payment instrument included therewith, including: means for selecting a graphic image for inclusion in the message, means for specifying customized text for inclusion in the message, means for specifying a payee for the negotiable payment instrument, means for selecting the monetary value of the negotiable payment instrument, means for specifying billing information for the message and the negotiable

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instrument, wherein the billing information includes a financial institution of the sender, means for requesting billing authorization from the financial institution of the sender, means for printing the message and negotiable payment instrument, and means for mailing the message and negotiable payment instrument to the recipient.

With respect to claim 29, the combination of *Simpson* and *McGurl* fails to teach or suggest, in a computer network system including a seller and a sender, the sender having access to an online server of the seller, a method of directing the seller to create and send to a recipient a printed negotiable payment instrument having a customized greeting message, comprising the steps of: receiving customized text from the sender for inclusion in the message, receiving a mailing address for the recipient from the sender, receiving payee information from the sender, the payee information specifying the payee for the negotiable payment instrument, enabling the sender to specify a monetary value of the negotiable payment instrument, receiving a requested mailing date from the sender, printing the negotiable payment instrument, the message included on a stub portion of the negotiable payment instrument, the negotiable payment instrument made payable to the payee and for an amount corresponding to the monetary value selected by the sender, and causing the printed negotiable instrument to be mailed to the mailing address of the recipient on the requested mailing date.

3. Level of Ordinary Skill in the Art

Applicant respectfully submits that the level of ordinary skill in the art is one who is skilled in the field of computer systems for online commerce.

4. Obviousness Analysis

Applicant respectfully submits that the claimed inventions, as summarized above, would not be obvious to one of ordinary skill in the computer programming art in view of *Simpson* and *McGurl*. As stated above, none of the references teach or suggest a method or system in which a buyer can direct a seller to prepare and deliver a customized paper greeting message with a negotiable instrument included therewith or attached thereto. Since these (and other) aspects of the Applicant's inventions are not taught or suggested by any of the

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references, it is not likely that one of ordinary skill in the art, namely, a computer system designer in the field of computer systems for online commerce, would find it obvious to create a method or system according to Applicant's claimed inventions. The omitted elements are not merely variations of the prior art, nor are they so well known that no reference is needed to supply the missing element. Thus, Applicant's claimed inventions would not be obvious to one of ordinary skill in the art over *Simpson* and *McGurl*.

5. Conclusion

Applicant respectfully submits that the Examiner has failed to make a *prima facie* case of obviousness over *Simpson* in view of *McGurl* to support a rejection under 35 U.S.C. §103. Furthermore, using the *John Deere* factual inquiries, Applicant submits that the differences between the prior art and the claimed inventions would not be obvious to one of ordinary skill in the art. Accordingly, Applicant respectfully requests withdrawal of this rejection.

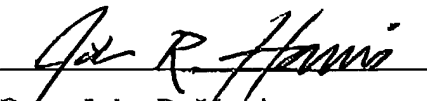
D. Summary of Argument

The issue of this appeal is whether claims 1-8 and 11-29 are obvious under 35 U.S.C. §103(a) over U.S. Patent No. 5,970,475 to *Simpson* in view of U.S. Patent 5,677,955 *McGurl*. There is no disclosure, teaching, or suggestion in *Simpson* that would render the claims obvious, and the teachings of *McGurl* are not sufficient to cure the deficiencies of *Simpson*. Applicant submits that the present invention, as claimed, is not obvious over the combination of *Simpson* and *McGurl* as viewed by a person of ordinary skill in the art. Because the combination of *Simpson* and *McGurl* does not disclose each element specified in the claims of the present application or suggest the invention defined by the claims, the record of this case indicates by a preponderance of the evidence that the claims of the present application are patentable over the cited art.

For at least the reasons stated above, Applicant respectfully requests that the Board of Patent Appeals and Interferences reverse the Examiner's rejections of the claims of the present invention and allow Claims 1-8 and 11-29.

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APPENDIX

LISTING OF CLAIMS

1. (Previously presented): In a computer network system including a seller and a sender, the sender having access to an online server of the seller, a method of directing the seller to create a printed greeting message having a negotiable payment instrument included therewith to a recipient, comprising the steps of:
 - (a) enabling the sender to select a graphic image for inclusion in the message to the recipient;
 - (b) enabling the sender to input customized text for inclusion in the message;
 - (c) enabling the sender to specify a payee for the negotiable payment instrument;
 - (d) enabling the sender to specify the monetary value of the negotiable payment instrument;
 - (e) requesting payment authorization for at least the monetary value of the negotiable payment instrument based on billing information provided by the sender; and
 - (f) after payment authorization has been obtained, printing the message and negotiable payment instrument by the seller, the message including the graphic image and customized text selected by the sender, the negotiable payment instrument including the payee and the monetary value selected by the sender.
2. (Original): The method according to claim 1, further comprising the steps of:
 - (a) enabling the sender to select an occasion for sending the message and payment instrument to the recipient;
 - (b) presenting the sender with a proposed graphic image and proposed customized text for inclusion in the message based on the occasion selected by the sender.
3. (Previously presented): The method according to claim 1, further comprising the step of displaying a data entry form to the sender over the computer network system, the form

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having a plurality of data entry fields for displaying the graphic image, the customized text, the payee, and the monetary value of the negotiable payment instrument.

4. (Original): The method according to claim 3, wherein data displayed in the plurality of data entry fields is modifiable by the sender.
5. (Original): The method according to claim 1, further comprising the step of receiving contact information for the recipient of the message.
6. (Original): The method according to claim 5, further comprising the step of enabling the sender to input the contact information for the recipient.
7. (Original) The method according to claim 5, further comprising the step of enabling the sender to select the recipient from an address book listing available recipients.
8. (Original): The method according to claim 1, further comprising the step of receiving contact information for the sender.
9. (Canceled)
10. (Canceled)
11. (Original): The method according to claim 1, further comprising the step of presenting the sender with a preview of the printed message and negotiable payment instrument.
12. (Original): The method according to claim 1, further comprising the step of enabling the sender to specify a delivery date for the message and negotiable payment instrument.

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13. (Original): The method according to claim 1, wherein the recipient and the payee are the same.
14. (Original): The method according to claim 1, wherein the recipient and the payee are different.
15. (Original): The method according to claim 1, wherein the negotiable payment instrument is removeably attached to the message.
16. (Original): The method according to claim 15, wherein the message and the negotiable payment instrument are printed on the same paper form.
17. (Previously presented): A computer network system for enabling a sender having access to a server of an online seller to order from the seller and have delivered directly to a recipient a customized greeting message having a negotiable payment instrument included therewith, comprising:
 - (a) means for selecting a graphic image for inclusion in the message;
 - (b) means for specifying customized text for inclusion in the message;
 - (c) means for specifying a payee for the negotiable payment instrument;
 - (d) means for selecting the monetary value of the negotiable payment instrument;
 - (e) means for specifying billing information for the message and the negotiable instrument, wherein the billing information includes a financial institution of the sender;
 - (f) means for requesting billing authorization from the financial institution of the sender;
 - (g) means for printing the message and negotiable payment instrument; and
 - (h) means for mailing the message and negotiable payment instrument to the recipient.

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18. (Original): The system according to claim 17, further comprising means for displaying a data entry form to the sender over a computer network, the form having a plurality of data entry fields for displaying the graphic, the customized text, and the monetary value of the negotiable payment instrument.
19. (Original): The system according to claim 18, wherein information displayed in the plurality of data entry fields is modifiable by the sender.
20. (Original): The system according to claim 17, further comprising means for selecting the occasion for sending the message and negotiable payment instrument.
21. (Original): The system according to claim 20, wherein the graphic image and customized text are pre-selected based on the occasion.
22. (Original): The system according to claim 21, wherein the graphic image and customized text are modifiable by the sender.
23. (Original): The system according to claim 17, further comprising means for displaying a preview of the printed message and the negotiable payment instrument to the sender.
24. (Original): The system according to claim 17, further comprising means for enabling the sender to specify a delivery date for the message and negotiable payment instrument.
25. (Original): The system according to claim 17, wherein the recipient and the payee are the same.
26. (Original): The system according to claim 17, wherein the recipient and the payee are different.

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27. (Original): The system according to claim 17, wherein the negotiable payment instrument is removeably attached to the message.
28. (Original): The system according to claim 27, wherein the message and the negotiable payment instrument are printed on the same paper form.
29. (Previously presented): In a computer network system including a seller and a sender, the sender having access to an online server of the seller, a method of directing the seller to create and send to a recipient a printed negotiable payment instrument having a customized greeting message, comprising the steps of:
- receiving customized text from the sender for inclusion in the message;
 - receiving a mailing address for the recipient from the sender;
 - receiving payee information from the sender, the payee information specifying the payee for the negotiable payment instrument;
 - enabling the sender to specify a monetary value of the negotiable payment instrument;
 - receiving a requested mailing date from the sender;
 - printing the negotiable payment instrument, the message included on a stub portion of the negotiable payment instrument, the negotiable payment instrument made payable to the payee and for an amount corresponding to the monetary value selected by the sender; and
 - causing the printed negotiable instrument to be mailed to the mailing address of the recipient on the requested mailing date.